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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/902,133	07/29/1997	LEONARD FORBES	303.356US1	9876
7590 06/01/2005			EXAMINER	
LUNDBERG WOESSNER & KLUTH			ECKERT II, GEORGE C	
P O BOX 2938 MINNEAPOLIS, MN 55402			ART UNIT	PAPER NUMBER
			2815	
		DATE MAILED: 06/01/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

<del></del>	Application No.	Applicant(s)				
	08/902,133	FORBES ET AL.				
Office Action Summary	Examiner	Art Unit				
	George C. Eckert II	2815				
The MAILING DATE of this communic	cation appears on the cover sheet wit	h the correspondence address				
A SHORTENED STATUTORY PERIOD FO THE MAILING DATE OF THIS COMMUNIC - Extensions of time may be available under the provisions of after SIX (6) MONTHS from the mailing date of this commu- lif the period for reply specified above is less than thirty (30) - If NO period for reply is specified above, the maximum state - Failure to reply within the set or extended period for reply we Any reply received by the Office later than three months aft earned patent term adjustment. See 37 CFR 1.704(b).	CATION.  of 37 CFR 1.136(a). In no event, however, may a reunication.  of days, a reply within the statutory minimum of thirty utory period will apply and will expire SIX (6) MONT will, by statute, cause the application to become ABA	rply be timely filed  (30) days will be considered timely.  FHS from the mailing date of this communication.  ANDONED (35 U.S.C. § 133).				
Status						
1) Responsive to communication(s) filed	d on <u>10 January 2005</u> .					
2a)⊠ This action is <b>FINAL</b> . 2l	b)☐ This action is non-final.					
3) Since this application is in condition for closed in accordance with the practic	, , , ,	•				
Disposition of Claims						
4) ⊠ Claim(s) 2-5,8-10,12-14,18-20,28,29, 4a) Of the above claim(s) is/are 5) □ Claim(s) is/are allowed. 6) ⊠ Claim(s) 2-5,8-10,12-14,18-20,28,29, 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restrict	e withdrawn from consideration. 32,35,36,39-71 and 73-78 is/are rej					
Application Papers						
9) The specification is objected to by the	Examiner.					
10) The drawing(s) filed on is/are:	☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.					
Applicant may not request that any object						
Replacement drawing sheet(s) including to 11) The oath or declaration is objected to	· · · · · · · · · · · · · · · · · · ·					
Priority under 35 U.S.C. § 119						
<u> </u>	documents have been received.  documents have been received in Apolitical of the priority documents have been hall Bureau (PCT Rule 17.2(a)).	oplication No received in this National Stage				
Attachment(s)						
<ol> <li>Notice of References Cited (PTO-892)</li> <li>Notice of Draftsperson's Patent Drawing Review (PT</li> </ol>	• =	ummary (PTO-413) )/Mail Date				
3) Information Disclosure Statement(s) (PTO-1449 or F Paper No(s)/Mail Date 1/14/05, 3/7/05.		formal Patent Application (PTO-152)				

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## **DETAILED ACTION**

### Response to Amendment

1. Applicant's amendment dated January 10, 2005 in which claims 28, 29, 32, 39, 41, 42, 44-48, 51, 52, 57-60, 65, 66, 69, 70 and 73-78 were amended and claims 6, 15, 34, 37 and 72 were canceled has been entered.

## Claim Objections

Claim 35 is objected to because of the following informalities: claim 35 still depends
 from claim 34 which claim was canceled. Claim 35 will be considered as depending from claim
 Appropriate correction is required.

### Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re/ Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35-36 and 39-71 and 73-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,031,263. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the claims of the '263 patent are more narrow than the instant claims and thus anticipate the instant claims.

Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-39, 59-61, 71-85, 98 and 99 of copending Application No.09/691,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '004 application are more narrow than the instant claims and thus are anticipatory.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-15, 22, 24-29, 31-35, 37-48, 50-53 and 55-57 of copending Application No. 08/903,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '486 application are to a species of device that anticipates the instant claims by providing a floating gate and insulator such that the barrier energy between them will be less than 3.3eV.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-31 of U.S. Patent No. 5,886,368. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because the instant claims cite a broad genus that is anticipated by the species claimed in patent '368.

8. Claims 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35-36 and 39-71 and 73-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,249,020. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '020 patent are drawn to a memory device having specific materials which anticipate the instantly claimed device.

## Response to Arguments

9. Applicant's arguments, filed January 10, 2005, have been fully considered and are persuasive, especially in light of the amendments. The obviousness rejections of all claims are withdrawn. Because the Double Patenting rejections remain, the case cannot yet be allowed.

## Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Eckert II whose telephone number is (571) 272-1728. The examiner can normally be reached on 8:00 - 5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GEORGE ECKERT
PRIMARY EXAMINER